

REMARKS

Claims 1-16, 18-23 and 26-85 stand rejected under 35 U.S.C. § 102(b). Claims 17, 24 and 25 stand rejected under 35 U.S.C. § 103(a).

Claims 1, 16, 17, 27, 28, 42, 52, 62, 71 and 82 are amended herein. Support for the amendments is found throughout the specification and specifically on page 8, lines 11-12. Therefore, no new matter is added by these amendments. Accordingly, Applicant respectfully requests entry of the amendments.

Claims 1-85 remain pending in the application. Applicant respectfully requests reconsideration and allowance of each pending claim in view of the following remarks.

Rejection under 35 U.S.C. § 102

A. Melius, et al. (5,601,542)

Claims 16, 18-19 and 26 remain rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,601,542 to Melius, et al. ("Melius"). Specifically, the Examiner indicates that "in response to Applicant's argument that the reference fails to show certain features of Applicant's invention, it is noted that the features upon which Applicant relies (i.e., an AUL value) are not recited in the claims." Office Action, page 13. Although Applicant believes the claims are not anticipated because the prior art does not disclose each and every element of the claim, Applicant has nevertheless amended the claims to further the prosecution of this case. In particular, claim 16 is amended to specifically recite the AUL value. Therefore, Applicant believes that the rejection is rendered moot by the amendment.

Accordingly, Applicant respectfully requests reconsideration and allowance of pending claims 16, 18-19 and 26.

B. Chmielewski (5,891,120)

Claims 1-16, 18-23 and 26-85 are rejected under U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,891,120 to Chmielewski ("Chmielewski"). In the Office Action, the Examiner asserts that the reference discloses a superabsorbent polymer having an AUL of less than 25 g/g under a load of 0.5 psi and recognizes that the reference is silent with regard to the Gel Integrity Index values specifically recited in the claims. However, the Examiner asserts that these values would be inherent in the claimed composition because the reference discloses "a superabsorbent polymer of the same type disclosed in the instant specification as having a Gel Integrity Index of less than about 500 kg mm." See Office Action, page 3.

Applicant has amended the claims to clarify that the present invention is directed to the use of a *superabsorbent polymer* having an AUL value of less than about 25 g/g at 0.3 psi, said AUL value being grams of a 0.9% by weight sodium chloride solution per grams of the superabsorbent polymer. In contrast, the reference refers to the AUL of the absorbent core. Also, the AUL value of the reference is determined at a different pressure, *0.5 psi*, compared to that of the present invention, 0.3 psi. See col. 4, lines 59-67. [emphasis added] Additionally, the teaching in the reference of "an absorbency under load (AUL) *not less than* about 12 grams/gram" (see col. 4, lines 24-26 [emphasis added]), in contrast to the preference of the present invention for low AUL values, clearly shows that the reference does not recognize and thus cannot teach the presently recited invention.

Further, the foregoing clarification with regard to the AUL values clearly demonstrates that the Gel Integrity Index values recited in the present claims are not inherently disclosed in the reference. Moreover, the recited Gel Integrity Index values are positive claim limitations. The disclosure by the reference of components in amounts that may be useful in the present invention does not anticipate the further limitation to specific Gel Integrity Index ranges. As indicated in the present specification, "persons of ordinary skill in the art would be readily able to prepare and

identify superabsorbent polymers meeting these characteristics, without undue experimentation . . . ” Page 8, lines 7-9. Thus, it is not necessary, for example, that the specification specifically disclose the process for preparing such superabsorbent polymers. The recitation of the Gel Integrity Index is sufficiently precise with regard to the superabsorbent polymer of the claimed invention.

In view of the foregoing, Applicant respectfully requests that the Examiner reconsider and withdraw the rejection and allow pending claims 1-16, 18-23 and 26-85.

Rejections under 35 U.S.C. § 103

To establish a *prima facie* case of obviousness, three basic criteria must be met: (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings, (2) there must be a reasonable expectation of success, and (3) the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP § 2142. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Applicant respectfully submits that the burden of establishing a *prima facie* case of obviousness has not been met by the Examiner in this case. Moreover, even if a *prima facie* case of obviousness was established, it would be rebutted by secondary evidence of nonobviousness.

A. Melius in view of Roberts

Claims 17, 24 and 25 are rejected under U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,601,542 to Melius, *et al.* as applied to claim 16, and (in the case of claims 24 and 25) further in view of U.S. Patent No. 3,875,942 to Roberts, *et al.* (“Roberts”).

For at least the reasons discussed above with regard to the novelty rejection, Applicant respectfully submits that Melius is deficient for a number of reasons, and namely the failure to disclose the AUL values (as now recited in claim 16 to clarify the invention). Roberts fails to remedy the deficiencies of Melius because it also fails to teach or suggest the recited AUL. Therefore, the references in combination do not teach or suggest all the elements of the claims, and do not support a *prima facie* case of obviousness. Accordingly, Applicant respectfully requests that the Examiner reconsider and withdraw the rejection and allow the pending claims.

B. Chmielewski in view of Roberts


Claims 17, 24 and 25 are rejected under U.S.C. § 103(a) as being unpatentable over by U.S. Patent No. 5,891,120 to Chmielewski as applied to claim 16, and (in the case of claims 24 and 25) further in view of U.S. Patent No. 3,875,942 to Roberts, *et al.*

In view of the foregoing arguments, Applicant submits that Chmielewski is deficient for number of reasons, and in particular for failing to disclose an absorbent article comprising an absorbent article that has a GII of less than about 500 kg mm, as recited by claim 16. Roberts fails to overcome the fundamental deficiency of the Chmielewski patent because it also fails to teach or suggest the recited physical properties of the superabsorbent. Therefore, the prior art references in combination do not teach or suggest all the claim limitations, and do not support a *prima facie* case of obviousness. Accordingly, Applicant respectfully requests that the Examiner reconsider and withdraw these rejections and allow the pending claims.

CONCLUSION

For at least the reasons outlined above, Applicant respectfully submits that the application is in condition for allowance. Favorable reconsideration and allowance of the pending claims are respectfully solicited. Should there be anything further required to place the application in better condition for allowance, Examiner Anderson is invited to contact Applicant's undersigned representative at the telephone number listed below.

Respectfully submitted,
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Dated: September 20, 2004

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